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10/588,784

08/08/2006

Yoshinori Gondoh

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04/01/2008

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EXAMINER

CHOI, PETER Y

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

04/01/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/588,784 | Applicant(s) GONDOH ET AL. | |
| | Examiner Peter Y. Choi | Art Unit 1794 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/08/06</u> . | 6) <input type="checkbox"/> Other: _____ |

NON-FINAL ACTION

Election/Restrictions

1. Applicants' election of Group I, claims 1-4, in the reply filed on February 7, 2008, is acknowledged. Because Applicants did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 5-7 and 9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claims 1-4, claim 1 recites a double glass cloth "characterized in that it is composed of" various structural limitations. The phrase "characterized in that" is unclear and indefinite as to what the scope of the claim entails, as "characterized in that" may be intended to include only the elements recited or may be intended to include the elements recited in addition to other elements or materials not recited.

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USPN 5,175,034 to De La Porte.

Regarding claims 1-4, De La Porte teaches a double glass cloth, characterized in that it is composed of warps and wefts and has a double structure comprising a face side structure and a back side structure, wherein said face side structure and said back side structure are bound with a woven structure into one piece (see entire document including column 1 line 4 to column 2 line 35, column 3 lines 22-49, column 4 line 24 to column 5 line 2, Figures 1-3).

Regarding claims 1-4, De La Porte does not appear to teach that the double glass cloth is used for a printed wiring board. However, the limitation appears to recite an intended use of the double glass cloth. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Since De La Porte teaches a substantially

similar structure and composition as the claimed double glass cloth, the invention of De La Porte appears to be capable of performing the intended use.

Regarding claim 2, the face side structure comprises face side warps which only weave said face side structure, face side wefts which only weave said face side structure and common yarns which weave both said face side structure and said back side structure, and the back side structure comprises back side warps which only weave said back side structure, back side wefts which only weave said back side structure and the common yarns which weave both said face side structure and said back side structure (column 1 line 4 to column 2 line 35, column 3 lines 22-49, column 4 line 24 to column 5 line 2, Figures 1-3).

Regarding claims 3 and 4, the face side structure and back side structure comprise a plain weave (column 3 lines 22-49).

Regarding claim 4, the face side structure and back side structure are bound together at a rate of at least one location per unit structure (column 1 line 4 to column 2 line 35, column 3 lines 22-49, column 4 line 24 to column 5 line 2, Figures 1-3).

In the event it is shown that De La Porte does not disclose the claimed invention with sufficient specificity, the invention is obvious because De La Porte discloses the claimed constituents and discloses that they may be used in combination.

5. Claims 1-4 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 56-58024 to Nishimura, as understood by the International Preliminary Report on Patentability.

JP 56-58024 is currently being translated to verify the contents of the publication.

Regarding claims 1-4, Nishimura teaches a double glass cloth, characterized in that it is composed of warps and wefts and has a double structure comprising a face side structure and a back side structure, wherein said face side structure and said back side structure are bound with a woven structure into one piece (see entire document including page 2 left column lines 9-20, page 2 right column lines 13-18, claim 1).

Regarding claims 1-4, Nishimura does not appear to teach that the double glass cloth is used for a printed wiring board. However, the limitation appears to recite an intended use of the double glass cloth. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Since Nishimura teaches a substantially similar structure and composition as the claimed double glass cloth, the invention of Nishimura appears to be capable of performing the intended use.

Regarding claim 2, the face side structure comprises face side warps which only weave said face side structure, face side wefts which only weave said face side structure and common yarns which weave both said face side structure and said back side structure, and the back side structure comprises back side warps which only weave said back side structure, back side wefts which only weave said back side structure and the common yarns which weave both said face side structure and said back side structure (page 2 left column lines 9-20, page 2 right column lines 13-18, claim 1).

Regarding claims 3 and 4, the face side structure and back side structure comprise a plain weave (page 2 right column lines 13-18).

Regarding claim 4, the face side structure and back side structure are bound together at a rate of at least one location per unit structure (page 2 left column lines 9-20, page 2 right column lines 13-18, claim 1).

In the event it is shown that Nishimura does not disclose the claimed invention with sufficient specificity, the invention is obvious because Nishimura discloses the claimed constituents and discloses that they may be used in combination.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Y. Choi whose telephone number is (571)272-6730. The examiner can normally be reached on Monday - Friday, 08:00 - 15:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1794

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew T Piziali/
Primary Examiner, Art Unit 1794

/Peter Y Choi/
Examiner, Art Unit 1794
March 26, 2008